Mailed: 14 AUG 2002
Paper No. 12
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re TekSystems, Inc.

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Serial No. 75/754,896

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Sherry H. Flax of Saul Ewing LLP for TekSystems, Inc.

Asmat A. Khan, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

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Before Simms, Cissel and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 20, 1999, TekSystems, Inc. (applicant) filed an application to register the mark TEK (in typed form) for services ultimately identified as “temporary and permanent placement of personnel in the information systems industry” in International Class 35 and “computer services, namely, computer consultation and systems management, integration of computer systems and networks and on-site monitoring of

computer systems in the information systems industry" in International Class 42.[1]

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark TEK RESOURCES (in typed form) for services identified as "temporary and contract employment services in the computer technology field; employment recruiting and counseling in the computer technology field."[2] The registration disclaims the word "resources."[3]

When the refusal was made final, applicant filed this appeal.

The examining attorney argues that "Tek" is the dominant portion of both marks and the presence of "resources" in the cited mark does not significantly change the commercial impression of that mark. The examining attorney found that in "the instant case, both parties have

[1] Serial No. 75/754,896. The application alleges a date of first use and a date of first use in commerce of September 1997. The application was amended to claim ownership of Registration No. 2,287,071 for the mark TEKSYSTEMS and No. 2,290,835 for the mark TS TEKSYSTEMS and design.
[2] Registration No. 2,075,297, issued July 1, 1997.
[3] The examining attorney also cited a second registration for the mark TEK RESOURCES INC. and design for the same services (Registration No. 1,945,003). Office records now indicate that this registration was cancelled for failure to file a Section 8 affidavit. Therefore, this registration no longer forms a bar to registration.

identical personnel placement services in the information technology field." Brief at 7. Finding that the "marks are highly similar and the services are identical" (Brief at 8), the examining attorney submits that there is a likelihood of confusion.

Applicant emphasizes the "resources" element of the cited mark. In addition, applicant argues that the term "Tek" is not inherently strong, and that "is entitled to a narrow scope of protection." Brief at 5. Applicant lists several registration numbers and marks and identifies them as being registered for "employment-related services." Id.[4] Applicant also argues that there has been only one incident of actual confusion since applicant began using its mark in 1997. Applicant concludes by arguing that the "weakness of the marks, the proliferation of 'tech' marks in the marketplace, and the differences between the subject marks

[4] Normally, a list of registration numbers submitted with an appeal brief would not be considered. 37 CFR § 2.142(d). However, the examining attorney did not object to this evidence and, in fact, discussed several of these referenced registrations. The examining attorney then went on to "acknowledge[] and concede[] the weakness of the term." Brief at 6. Therefore, because the examining attorney has not objected, we will consider applicant's list of registrations although the weight to be given to a list of registrations without an underlying copy of the registration itself is limited. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[E]ven were we to consider the search report credible evidence…, absent evidence of actual use of the marks subject of the third-party registrations, they are entitled to little weight on the question of likelihood of confusion").

are sufficient to obviate any reasonable likelihood of consumer confusion." Brief at 7.

Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973. See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by addressing the similarities and dissimilarities between the marks in the application and registration. Applicant seeks registration of the mark TEK in typed form. Registrant's mark is for the words TEK RESOURCES in typed form. Both marks contain the same word TEK. The disclaimed word "resources" does not sufficiently distinguish the two marks. First, disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). Second, a "resource" is defined as "a source of supply, support, or aid, esp. one held in

reserve." The term "human resources" is defined as "people, esp. the personnel employed by a given company, institution, or the like." *Random House Dictionary of the English Language Second Edition Unabridged* (1987).[5] In this case, TEK, the only other feature of the mark that is not disclaimed, is a more significant feature of the registered mark than the disclaimed, descriptive word "resources."

At a minimum, the marks TEK and TEK RESOURCES are similar. The additional feature of the registered mark "resources" is not sufficiently distinctive to distinguish the marks. The marks look similar, even misspelling the term "tech" the same way. The differences in sight and sound are minimal and both have similar meanings for employment services, i.e., they both suggest that the businesses supply technologically savvy personnel to companies and other entities in need of assistance in this area.

Regarding the services, applicant does not dispute the examining attorney's position that the services are identical. We agree that applicant's "temporary and permanent placement of personnel in the information systems

[5] We, of course, can take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

industry" and registrant's "temporary and contract employment services in the computer technology field" certainly are at least identical in part. Both services place personnel in the information system field. Indeed, applicant underscores the identical nature of the services because it reports that registrant forwarded several resumes to applicant that registrant mistakenly received. Bowie declaration, ¶ 2.

Because the marks are used, at least in part, in connection with identical services, there is a greater likelihood that when similar marks are used in this situation, confusion will be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

The main issue in this case is whether the mark TEK RESOURCES is so weak that it is entitled to virtually no scope of protection. While the examining attorney has "acknowledge[d] and concede[d] the weakness of the term," the examining attorney goes on to argue that "the marks are so highly similar for identical services in the same industry that the weakness of the term does not obviate the

2(d) refusal." Brief at 6. We are persuaded by the following factors that there is a likelihood of confusion regarding the placement services.

One, the services are virtually identical. Two, the marks have the identical misspelling of the only non-disclaimed term. Three, applicant reports that there has been at least one incident of actual confusion. Four, the registration is on the Principal Register with only a disclaimer of the term "resources." It is, therefore, entitled to a presumption of validity. 15 U.S.C. § 1057(b). Five, applicant has not submitted copies of the registrations that it claims demonstrate that the mark is weak. Hub Distributing, 218 USPQ at 285 ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"). See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994); In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). Copies of the registrations would have been evidence of how the term may be defined in the relevant industry but they would not be evidence of how the term is perceived in the marketplace. Six, "even weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services." In re Colonial Stores, 216 USPQ 793, 795

(TTAB 1982). The Court of Customs and Patent Appeals even rejected the argument that marks on the Supplemental Register can only be used to refuse registration for identical marks. In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover). Seven, to the extent we have any doubts on the issue of likelihood of confusion, we must resolve them in favor of the registrant. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

However, regarding applicant's services for "computer services, namely, computer consultation and systems management, integration of computer systems and networks and on-site monitoring of computer systems" in International Class 42, neither applicant nor the examining attorney has discussed these services in any detail. Obviously, these services are not identical to the services in the cited registration. Therefore, when we consider the weakness of the mark and the fact that these services are not identical to the services in the cited registration, we conclude that there is no likelihood of confusion.

Decision: The Examining Attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered mark under Section 2(d) of the Trademark Act for the services in International Class 42 is reversed. The refusal under Section 2(d) of the Trademark Act for the services in International Class 35 is affirmed.